

REMARKS

This Amendment, submitted in response to the Office Action dated January 10, 2005, is believed to be fully responsive to each point of rejection raised therein. Accordingly, favorable reconsideration on the merits is respectfully requested.

Claims 6, 7, and 21-33 are now pending in the present application.

I. Information Disclosure Statement

Applicant respectfully requests that the Examiner initial, without annotation, the PTO Form-1449 filed on May 6, 2004. The references cited in the Japanese Office Action correspond to the U.S. Patents and Publication listed in the Form-1449 filed on June 22, 2004. It appears that all relevant information has been placed before the Examiner. In that connection, Applicant respectfully requests that the Examiner initial all of the references identified on the PTO Form-1449 filed on May 6, 2004.

II. Claim Rejections under 35 U.S.C. § 102

Claims 6, 7, 21, 22 and 25-29 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Stimpson (U.S. Patent No. 6,037,186) as evidenced by Hayes et al. (U.S. Patent No. 4,877,745).

The Examiner asserts that Stimpson teaches the aspects of claims 6 and 26. However, it appears that Stimpson teaches away from the present invention. For example, in col. 2, lines 49-51, Stimpson discloses that "since elements of the array are formed by the application of a DNA solution to the surface of the array the process is relatively slow." This appears contrary to the

present invention in which binding agents are applied to the surface of a substrate. Therefore, the teachings of an exemplary embodiment of the invention appear contrary to Stimpson.

Further, it would appear that in Stimpson, the reagent is applied in a direction perpendicular to a longitudinal direction of the 21.5 foot sheet (See Fig. 2C), and is not in lines in the longitudinal direction of the strip-like substrate, as recited in the claims.

The claims further recite “a cutting means which cuts the *sheet-like substrate* bearing thereon the plurality of specific binding agents in the first direction into a plurality of strips.” However, at no point is cutting of a strip-like substrate performed Stimpson. In particular, cutting is performed in Stimpson after a sheet is rolled into a rod shape. See col. 5, lines 33-36; Figs. 1C, 2E, and 2D.

Further, the Examiner asserts that although Stimpson and Hayes do not specifically indicate that their apparatus can perform the functions of the apparatus recited in the claims, that claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. However, a functional limitation must be evaluated and considered just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. MPEP 2173.05.

For example, claim 26 is directed to an applying means, conveying means, and cutting means. The claimed means-plus-function limitations require the Examiner to give patentable weight to the function of the recitation (See 35 U.S.C. § 112, sixth paragraph, and MPEP § 2184). The application of a prior art reference to a means or step plus function limitation

requires that the prior art perform the identical function specified in the claim (MPEP § 2182). If a prior art reference teaches the identical function specified in the claim, then the Examiner carries the initial burden of proof to show that the prior art structure is equivalent to the structure described in the specification, which has been identified as corresponding to the claimed means (MPEP § 2182). Therefore, the functional language must be given due consideration.

For at least the above reasons, claims 6 and 26 and their dependent claims should be deemed patentable.

III. Claim Rejections under 35 U.S.C. § 103

Claims 23 and 24 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Stimpson as evidence by Hayes et al. and further in view of Shuminov (U.S. Patent No. 5,808,554). Claims 23 and 24 should be deemed patentable by virtue of their dependency to claim 6 for the reasons set forth above.

Moreover, claim 24 is directed to a cutting means, therefore, consideration should be given to the functional recitation of the claims as discussed above.

IV. New Claims

Applicant has added claims 30-33 to provide a more varied scope of protection. Claims 30-33 should be deemed patentable by virtue of its dependency to claims 6 and 24 for the reasons set forth above.

AMENDMENT UNDER 37 C.F.R. § 1.111
Appln. No.: 09/373,585

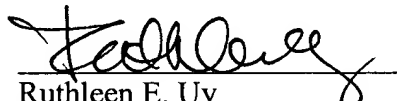
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V. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


Ruthleen E. Uy
Registration No. 51,361

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

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